

REMARKS

Claims 1–3 and 5–10 are pending in this application. By this Amendment, claims 1–3 and 5–10 are amended, and claim 4 is cancelled. Support for the amendments to claim 1 can be found in original claim 4, and in the specification at, for example, paragraphs [0044] and [0045], and in Tables 2 and 3. Amendments to claims 2, 3, and 5–10 were made to improve the clarity of the claims, and not for reasons relating to patentability, or were made in view of cancellation of claim 4. Support for the amendments to claims 2, 3, and 5–10 may be found, for example, in original claims 2, 3, and 5–10. No new matter is added. In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

Rejections Under 35 U.S.C. §103**A. Japan '209**

The Office Action rejects claims 1 and 3–5 under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent Document No. 2002-280209 ("Japan '209"). By this Amendment, claim 4 is cancelled, rendering the rejection moot as to that claim. As to the remaining claims, Applicants respectfully traverse the rejection.

Claim 1 recites "[a] method for producing a powdered core, comprising: preparing a mixture comprising a soft magnetic powder and a resin powder; compacting the mixture into a predetermined shape to obtain a green compact; and heating the green compact; wherein: the resin powder has a median size of not more than 50 μm , and the resin powder amount is 0.01 to 2.65% by volume; and the resin powder is a thermosetting polyimide resin, a thermoplastic polyimide resin, or a polytetrafluoroethylene resin" (emphasis added). Japan '209 does not teach or suggest such a method.

The Office Action correctly points out that Japan '209 discloses a method of making a powdered core in which a resin powder is employed in an amount of 0.5 to 5 mass% of the

mixed dust core. In particular, Japan '209 discloses employing 0.5 to 5 mass% of a phenol resin powder (converted to volume%, the range of phenol resin powder employed in the method of Japan '209 would be 2.9 to 23.9% by volume). *See* paragraph [0012]. Claim 1 requires that a resin powder be employed in an amount of from 0.01 to 2.65% by volume, the resin powder being a thermosetting polyimide resin, a thermoplastic polyimide resin, or a polytetrafluoroethylene resin. Japan '209 does not disclose using any of the resins recited in claim 1, much less in the amount recited in claim 1.

The Office Action relies on an alleged overlap of the amount of resin used in Japan '209 and the amount of resin recited in claim 1 to make a *prima facie* case of obviousness. However, as discussed above, there is no overlap between the amount of resin disclosed in Japan '209 and the amount of resin recited in claim 1. Accordingly, a *prima facie* case of obviousness cannot be made.

As Japan '209 fails to teach or suggest employing 0.01 to 2.65% by volume of a thermosetting polyimide resin, a thermoplastic polyimide resin, or a polytetrafluoroethylene resin, Japan '209 fails to teach or suggest each and every feature of claim 1.

Claim 1 would not have been rendered obvious by Japan '209. Claims 3–5 depend from claim 1 and, thus, also would not have been rendered obvious by Japan '209. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

B. Japan '209 and AAPA

The Office Action rejects claims 8–10 under 35 U.S.C. §103(a) as being unpatentable over Japan '209 in view of Applicants' Admitted Prior Art ("AAPA"). Applicants respectfully traverse the rejection.

Claim 1 is set forth above. As discussed above, Japan '209 does not teach or suggest the method of claim 1. AAPA is cited for its alleged teaching of machining a dust core to its final configuration. However, AAPA, like Japan '209 fails to teach or suggest employing

0.01 to 2.65% by volume of a thermosetting polyimide resin, a thermoplastic polyimide resin, or a polytetrafluoroethylene resin. As neither Japan '209 nor AAPA teaches or suggests employing 0.01 to 2.65% by volume of a thermosetting polyimide resin, a thermoplastic polyimide resin, or a polytetrafluoroethylene resin, the combination of references fails to teach or suggest each and every feature of claim 1.

Claim 1 would not have been rendered obvious by Japan '209 and AAPA. Claims 8–10 depend from claim 1 and, thus, also would not have been rendered obvious by Japan '209 and AAPA. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

C. Iyoda

The Office Action rejects claims 1–7 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0127157 A1 to Iyoda et al. ("Iyoda"). By this Amendment, claim 4 is cancelled, rendering the rejection moot as to that claim. As to the remaining claims, Applicants respectfully traverse the rejection.

Iyoda is not available as prior art against the instant claims. Iyoda was published on July 10, 2003, based on a U.S. patent application filed December 18, 2002. The instant application was filed on April 12, 2005 as the national stage of International Application No. PCT/JP03/12515 filed on September 30, 2003, which, in turn, claims priority to Japanese Application No. 2002/285141 filed on September 30, 2002. A translation of Japanese Application No. 2002/285141 is attached hereto. As instant claims 1–3 and 5–10 are fully supported by the disclosure of Japanese Application No. 2002/285141, the present application is entitled to the September 30, 2002 filing date of the priority application.

Iyoda was not published before September 30, 2002, and thus is not available as prior art against the instant application under 35 U.S.C. §102(a) or §102(b). The U.S. patent application of which Iyoda is a publication, was not filed before September 30, 2002, and thus

is not available as prior art against the instant application under 35 U.S.C. §102(e).

Accordingly, Iyoda is not prior art to the instant claims.

Iyoda cannot form the basis of a rejection of the instant claims. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

D. Iyoda and AAPA

The Office Action rejects claims 8–10 under 35 U.S.C. §103(a) as being unpatentable over Iyoda in view of AAPA. Applicants respectfully traverse the rejection.

As indicated above, Iyoda cannot form the basis of a rejection of the instant claims. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1–3 and 5–10 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachment:

English-language Translation of JP 2002/285141

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